

### **REMARKS**

In this amendment, claims 38-48 have been cancelled without prejudice to their being pursued in a concurrently filed continuation application, and claims 29 and 36 have been amended. Claims 1-28 have been previously cancelled, so claims 29-37 remain pending.

#### **Objection Under 37 C.F.R. § 1.75(c)**

Claims 37 and 42-47 have been objected to under 37 C.F.R. § 1.75(c) for being in improper form. In this amendment, claim 36 has been amended to depend only from claim 35. Thus, claim 37, which is dependent on claim 36, is no longer in improper form. Claims 42-47 have been cancelled without prejudice to their being pursued in a concurrently filed continuation application. Accordingly, Applicants respectfully request that this objection be withdrawn.

#### **Rejections Under 35 U.S.C. § 112**

Claims 41 and 48 have been rejected as allegedly failing to comply with the written description requirement. As mentioned above, claims 41 and 48 have been cancelled without prejudice to their being pursued in a concurrently filed continuation application, thus rendering this rejection moot.

#### **Rejection Under 35 U.S.C. § 103(a)**

Claims 38-40 have been rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Jager et al. (U.S. Pat. No. 5,955,058) in view of Britto (U.S. Pat. No.

6,149,892). As mentioned above, claims 38-40 have been cancelled without prejudice to their being pursued in a concurrently filed continuation application, thus rendering this rejection moot.

### **Obviousness Type Double Patenting Rejections**

Claims 29-36 and 38-40 have been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Pat. No. 6,610,273 B2. As mentioned above, claims 38-40 have been cancelled without prejudice to their being pursued in a concurrently filed continuation application, thus rendering the rejection of these claims moot. With respect to claims 29-36, Applicants note that a Restriction Requirement was made in grandparent Application No. 09/592,885 (which matured into U.S. Pat. No. 6,315,985) between claims directed to medicinal aerosol steroid solution formulations such as those claimed herein and methods such as those claimed in the '273 patent. Accordingly, a rejection based on obviousness type double patenting over the method claims of the '273 patent is improper under 35 U.S.C. § 121 and should be withdrawn.

Claims 29-36 and 38-40 have also been rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims of U.S. Pat. No. 6,315,985 B2. As mentioned above, claims 38-40 have been cancelled without prejudice to their being pursued in a concurrently filed continuation application, thus rendering the rejection of these claims moot. With respect to claims 29-36, Applicants submit herewith a Terminal Disclaimer to obviate the obviousness-type

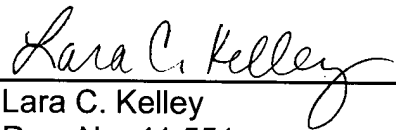
double patenting rejection over U.S. Pat. No. 6,315,985 in order to expedite prosecution of this application. In view of the attached Terminal Disclaimer, Applicants respectfully request withdrawal of the obviousness-type double patenting rejection of claims 29-36.

Please grant any extensions of time required to enter this amendment and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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